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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,295	11/06/2003	Joseph Barbosa	QA0253 NP	8067
23914 7590 03/08/2007 LOUIS J. WILLE BRISTOL-MYERS SQUIBB COMPANY PATENT DEPARTMENT P O BOX 4000 PRINCETON, NJ 08543-4000			EXAMINER COLEMAN, BRENDA LIBBY	
			ART UNIT 1624	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/08/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/702,295

Applicant(s)

BARBOSA ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,6-10,15,16 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 1,4,6-10,15,20 and 22 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1, 4, 6-10, 15, 16 and 20-22 are pending in the application.

This action is in response to applicants' amendment dated December 4, 2006.

Claims 1, 6-10, 16 and 20-22 have been amended and claims 2 and 3 have been canceled.

### *Response to Arguments*

Applicant's arguments filed December 4, 2006 have been fully considered with the following effect:

1. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112; second paragraph rejections labeled paragraph 3i), y), z), aa), ab), ac), ad) and ae) maintained in the last office action, which are hereby **withdrawn**.
2. The applicants amendments and arguments are sufficient to overcome the objection under 35 U.S.C. 132(a) labeled paragraph 6) of the last office action, which is hereby **withdrawn**.
3. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection labeled paragraph 7) of the last office action, which is hereby **withdrawn**.
4. The applicants' amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 8a), b), d), e), f), g) and h) of the last office action, which are hereby **withdrawn**. However, with regards to the

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35 U.S.C. § 112, second paragraph rejection labeled c) the applicants' amendments and remarks have been fully considered but they are not found persuasive.

c) The applicant's stated that the second occurrence of 4-NH<sub>2</sub>C(=O)-benzyl moiety in claim 8 has been deleted but this is not so.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention, for reasons of record and stated above.

In view of the amendment dated December 4, 2006, the following new grounds of rejection apply:

***Specification***

5. The disclosure is objected to because of the following informalities: the amendment to the specification on page 2 of the amendment filed December 4, 2006 contains the following informalities:

- a) The moiety (heterocylco)alkyl in lines 2 and 6 of subparagraph (i) is missed spelled.
- b) The moiety T<sup>17</sup>C(O)<sub>i</sub>N(T<sup>11</sup>)T<sup>10</sup> in line 7 of subparagraph (i) is missing the point of attachment.
- c) The moiety S(O)<sub>i</sub>N(T<sup>11</sup>)T<sup>10</sup> in line 7 of subparagraph (i) is missing the point of attachment.
- d) The moiety -T<sup>12</sup>-N(T<sup>16</sup>)-T<sup>15</sup>-T<sup>10</sup> contains the variable -T<sup>15</sup>- which is not defined as a divalent moiety in line 8 of subparagraph (i).

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e) The moiety  $T^{17}C(O)_iN(T^{11})T^{10}$  in line 2 of subparagraph (ii) is missing the point of attachment.

f) The moiety  $S(O)_iN(T^{11})T^{10}$  in line 2 of subparagraph (ii) is missing the point of attachment.

g) The moiety  $-T^{12}-N(T^{16})-T^{15}-T^{10}$  contains the variable  $-T^{15}-$  which is not defined as a divalent moiety in line 3 of subparagraph (ii).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6, 8-10, 15 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The moiety  $-S(O)_iN(T^{11})T^{22}$  in the definition of  $T^{11}$ ,  $T^{14}$ ,  $T^{15}$ ,  $T^{16}$  and  $T^{19}$  and  $T^{20}$  and  $T^{21}$  is not described in the specification with respect to the genus of Formula (Ia). See page 10 and 11.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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7. Claims 1, 4, 6-10, 15, 20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claims 1, 9, 10, 15 and 20 are vague and indefinite in that it is not known what is meant by the variable  $R^2$  in Formula (I), which is not defined within the claim.
- b) Claims 1, 4, 9, 10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety at the bottom of page 3.
- c) Claims 1, 4, 9, 10, 15 and 20 are vague and indefinite in that it is not known what is meant by the first two lines of moieties at the top of page 4.
- d) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety heteroc~~yl~~o in the definition of  $R^6$ .
- e) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety heteroc~~yl~~o in the definition of  $R^9$  and  $R^{10}$ .
- f) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the definition of  $T^1$ ,  $T^2$  or  $T^3$  where there are no variables  $T^1$ ,  $T^2$  or  $T^3$  in Formula (I).
- g) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety (heteroc~~yl~~co)alkyl in the definition of  $T^1$ - $T^9$ .
- h) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety (heteroc~~yl~~o)alkyl in the definition of the substituents on  $T^1$ - $T^9$ .

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- i) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety  $-T^{17}C(O)_iN(T^{11})T^{10}-$  in the definition of the substituents on the moieties of  $T^1-T^9$ , which contains two points of attachment.
- j) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety  $-S(O)_iN(T^{11})T^{10}-$  in the definition of the substituents on the moieties of  $T^1-T^9$ , which contains two points of attachment.
- k) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety  $-T^{17}C(O)_iN(T^{11})T^{10}-$  in subparagraph (ii) in the definition of the moieties of  $T^1-T^9$ , which contains two points of attachment.
- l) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety  $-S(O)_iN(T^{11})T^{10}-$  subparagraph (ii) in the definition of the moieties of  $T^1-T^9$ , which contains two points of attachment.
- m) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety (heterocyo)alkyl in the definition of the substituents on  $T^{11}$ ,  $T^{14}$ ,  $T^{15}$ ,  $T^{16}$  and  $T^{19}$ .
- n) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety (heterocylco)alkyl in the definition of  $T^{20}$  and  $T^{21}$ .
- o) Claims 1, 4, 6-10, 15 and 20 are vague and indefinite in that it is not known what is meant by the moiety (heterocyo)alkyl in the definition of the substituents on  $T^{20}$  and  $T^{21}$ .

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- p) Claim 4 is vague and indefinite in that it is dependent upon a canceled claim.
- q) Claim 4 recites the limitation "R<sup>2</sup>" in the third line of the claim. There is insufficient antecedent basis for this limitation in the claim.
- r) Claim 22 is vague and indefinite in that it is not known what is meant by the moiety (heterocyo)alkyl in the definition of the substituents on T<sup>15</sup>.

### ***Claim Objections***

- 8. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Allowable Subject Matter***

- 9. Claim 21 is allowed. None of the prior art of record or a search in the pertinent art area teaches the species as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brenda L. Coleman  
Primary Examiner Art Unit 1624  
March 3, 2007